

REMARKS

Claims 1-9, all the claims pending in the application, stand rejected. Applicants have not amended any claims, but do request an interview with the Examiner if there are issues remaining that can be resolved.

Claim Rejections - 35 U.S.C. § 102

Claims 1 and 5-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Osamu et al (EP 1145748). This rejection is traversed for at least the following reasons.

As a preliminary matter, Applicants note that the Examiner has repeated the identical text of the rejection that was presented in the first Office Action. Thus, Applicants' arguments presented in the Amendment filed on September 25, 2007, would continue to apply. Applicants note, however, that the Examiner has responded to those arguments at pages 11-16 of the present Office Action. Thus, Applicants respectfully present their reply to the Examiner's comments.

Claim 1

As a preliminary matter, Applicants note that claim 1 is independent and includes several limitations in "means-plus-function" form.

Replication Means

These limitations include a "replication means." The **stated function** is "for storing game data into the replication target game data storage means on the basis of game data stored in the replication source game data storage means," and the claim further specifies that "the replication means stores the game data into the replication target game storage means on the basis of the game data stored in the replication source game data storage means so that a sum of the number of original items relating to the original item data stored in the replication source game data storage means and the number of replica items relating to the replica items data stored in the replication source game data storage means becomes the number of replica items relating to the replica item data stored in the replication target game data storage means, and stores the link data to correlate the replication target game data storage means with the replication source game data storage means into the link data storage means."

As explained at pages 9 and 10 of the Amendment filed on September 25, 2007, such functional limitations must be interpreted in accordance with the provisions of 35 U.S.C. § 112, paragraph 6. This requirement is acknowledged by the USPTO in MPEP § 2181.

Identical Function Required

At page 9 of the previous amendment, Applicants argued that an **identical function** is required for anticipation of a means plus function limitation. Applicants cited § 2183 of the MPEP in support of this position. There it is stated:

1. “If the Examiner finds that a prior art element
2. (A) performs the functions specified in the claim,
3. (B) is not excluded by any explicit definition provided in the specification for an equivalent, and
4. (C) is an equivalent of the means- (or step-) plus-function limitation,

the Examiner should provide an explanation and rationale in the Office Action as to why the prior art is an equivalent. Factors that will support a conclusion that the prior art element is an equivalent are:

(A) the prior art element performs the **identical function** specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification.....”.

As asserted by Applicants, an **identical function** must be found in the prior art for there to be anticipation, as required by the MPEP and the underlying case law.

As explained at pages 12 and 13, the “counting means” of Osamu as disclosed at col. 4, lines 6-10 to keep track of exchange items does not teach the entire **identical function** recited for the “replication means.” Thus, Applicants also asserted that the Examiner fails to identify any teaching of the precise literal function stated in the claims.

The Examiner’s Response to Arguments does not remedy this deficiency by explaining how each and every word in the above repeated function of the replication means is found in Osamu . At page 11, the Examiner merely “respectfully disagrees” and states that “the reference substantially teaches a replication part stores game data...”.

First, this is an express admission by the Examiner that there is no identical teaching of the claimed function. “Substantially teaches” is not identically teaches. Indeed, as pointed out by the Applicants at pages 12 and 13 of the previous Amendment, the “replication means” is more than simply a counter. At its simplest level, it performs a summing and storage function, neither of which is seen in Osamu et al. Applicants referred to paragraph [0015] of Osamu where the counting means is for (1) counting a number of times where the game item exchange means exchanges game items and (2) determining the at least one exchange object game item based on the number of times.

There is no mention of a summing operation, whereas a sum of a first number is added to a sum of a second number and becomes a number of replica units, as claimed. Further, there is no teaching or suggestion of calculating with respect to both original items and replica items. Thus, there is no identical function.

No Corresponding Structure

Further, as to the second and separate requirement for a corresponding structure, the “counting means” of Osamu et al does not act as a summer, and cannot be identical or an equivalent to a summer due to missing arithmetic functions. Further, the counting and determining operations in Osamu for the “time counting means” does not operate to store game data into a replication target game data storage means on the basis of a number of original items and number of replica items.

Thus, there can be no anticipation as there is no identical function and no identical or equivalent corresponding structure.

Link Storage Means

Applicants also asserted that there is no “link data storage means,” for storing link data to correlate the replication target game data storage means with the replication source game data storage means as argued at page 11 of the previous Amendment.

The Examiner addresses this argument at page 12 of the Office Action and again “respectfully disagrees.” The Examiner points to a game program in the ROM cartridge 12 as executed by portable game machines in lines 3-7 on page 11 of the application. The Examiner also points to Fig. 1 and the disclosure of a “portable game device, game program [0020] and

ROM cartridge [12 in Fig. 1].” The Examiner states Osamu et al is considered to be an equivalent to Applicants’ link data storage means because it performs the same function in substantially the same way and produces substantially the same result as the corresponding element in Applicants’ specification.

Again, the function is not identical. Thus, the analysis fails the statutorily mandated test. The Examiner is simply using broad and indefinite interpretations of specific claim language to assert anticipation. This approach is clearly at odds with the requirements of 35 U.S.C. § 112, paragraph 6 and the guidance provided in the MPEP at § 2183.

Finally, the Examiner argues at page 13 that “if the structure suggested by the prior art is identical to the present invention, then the function may be inherent or intrinsic to the structure, citing MPEP § 2114. However, it is clear from applicable law that “a single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). Inherent anticipation requires that the missing descriptive material is “necessarily present,” not merely probably or possibly present, in the prior art. *In re Robertson*, 169 F3d 743, 745, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999). The combination of a computer, memory and application can have many different functions, depending on the application itself. The Examiner’s position is equivalent to saying that all computer-based devices are the same, even if their functions are dramatically different, simply because they have a processor, a memory and an application.

The present case is one where the Examiner is interpreting the claims too broadly and misapplying the law despite clear guidance from applicable U.S. law and USPTO guidelines. A personal interview is requested to review the applicable law and possibly clarifying language if deemed necessary by the Examiner.

Claim Rejections - 35 U.S.C. § 103

Claims 2-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Osamu et al, as applied to claim 1, in view of Holenstein et al (7,103,586). This rejection is traversed for at least the following reasons.

With regard to the fundamental flaws in the Osamu reference, Applicants respectfully submit that Holenstein does not remedy these deficiencies. Also, Holenstein does not provide the teachings that would enable one of ordinary skill in the art to modify the counter of Osamu to have the specific functional limitations stated in the claim for the “replication means.” Further, there is no teaching or suggestion of a “link data storage means” for storing link data to correlate to game data storage means with each other such that the replication means “stores the link data to correlate to replication target game data storage means with the replication source game data storage means into the link data storage means.”

Finally, the Examiner uses the standard USPTO response to Applicants’ arguments against obviousness by asserting that a feature of a secondary reference need not be bodily incorporated into the structure of the primary reference or that there should be some express suggestion in any one or all of the references. The Examiner states that the test is “what the combined teachings of the reference would have suggested to those of ordinary skill in the art.”

No Decreasing a Number of Replica Items

However, in Applicants’ arguments, it is not asserted that one reference must be incorporated into the other reference. Instead, Applicants are asserting that no reference teaches or suggests decreasing a number of replica items. In the absence of such feature, the claims cannot be anticipated or rendered obvious. The basic goal of the invention, which is to reduce the number of replica items that are stored, cannot be attained by Osamu alone or together with Holenstein. Applicants expressly stated that there is no basis for recognizing even the problem and its solution to the excessive storage of original and replica item data in either reference. Thus, there is no basis for the function or the structure as claimed.

Conclusion

Applicants have demonstrated that the prior art fails to teach the limitations of the pending claims, when properly interpreted according to applicable law. Applicants request an interview with the Examiner to review that law if the Examiner disagrees, so that the cost and time required for unnecessary extended prosecution of the present application can be avoided.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

RESPONSE UNDER 37 C.F.R. § 1.116
Application No.: 10/519,108

Attorney Docket No.: Q85461

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Alan J. Kasper/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Alan J. Kasper
Registration No. 25,426

Date: July 8, 2008